

1 **(4) REMARKS**

2
3 **RESPONSE TO REJECTION UNDER ACTION PARA. 1**

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5 Copies of documents are attached as requested.

6
7 **RESPONSE TO REJECTION UNDER ACTION PARA. 2 & 3**

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9 Claim 1 (independent) and claim 2 depending therefrom are rejected in view of U.S. Pat. No.
10 6,456,307 (Bates).

11
12 It is axiomatic that claims are not to be interpreted in a vacuum. Slimfold Mfg. Co. v.
13 Kinthead Indus., 810 F.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987); Moleculon Res. Corp. v. CBS,
14 Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim and specification language
15 must be considered. DMI, Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985).
16 By ignoring the present application's use of the claims limitations as discussed in the Detailed
17 Description, the argument as set forth in the Action ignores this requirement. Understanding, or
18 Interpreting, a limitation *already in a claim* in light of the Detailed Description is not the same as
19 an impermissible reading of a limitation into a claim. Otherwise, these court decisions are
20 rendered meaningless.

21
22 What has been disclosed by Lemon for the main part in the present application and argued in
23 previous responses to Office Actions is the use of a temporary mnemonic-type freehand writing
24 on a computer tablet which associates the writing with the site address such that the writing
25 becomes a temporary link to the site. For example, access 3 web sites, make 3 associated
26 writings on the tablet, and tap the writings to access and re-access those sites. Claim 1 by
27 Lemon herein specifies,

28
29 "...an electronic tablet having visible marking capability;
30 a marking stylus associated with the tablet;" ***

1 " ...device for associating at least one temporarily marked location ...".

2
3 Bates is not recognized by the applicant to be such a spontaneous device for generating a
4 temporary web site link using a tablet link and thus does not show the elements of this claim,
5 particularly when taken as a whole and in consideration of the specification by Lemon.

6 As with the previously cited reference Dickman, Bates et al. is an on-screen icon generator
7 method and apparatus. Sophisticated software changes to a browser is required in Bates et al.:

8 "The browser selects a subset of the page,and transforms the subset to an icon.

9 The browser then displays...." Abstract.

10 This is undeniably a mechanism for generating an on-screen icon just as was Dickman. All of
11 the arguments provided by the applicant against Dickman are incorporated herein by reference.
12 In fact, Bates generates on-screen icons that actually consume precious display space; each
13 web page of interest has a separate browser invocation which, in turn, has its own generated
14 icon. Due to the way they are created, each Bates icon will be larger than an ordinary, generic
15 icon. Attempting to apply Bates' technique to the browsing of ephemeral pages will quickly fill
16 up the computer display with icons. This is not at all the solution provided by present applicant
17 Lemon, who in fact avoids this display problem by use of the tablet and temporary mnemonic
18 devices.

19
20 The Action also alleges:

21 "However, Bates does not go into depth on the possible GUI alternatives *** specifically
22 sighting [sic, citing] a graphic table as the first alternative to the *conventional mouse*."

23 Emphasis added.

24 Applicant Lemon neither describes nor claims using a tablet for a mouse pointing applications
25 as Bates in his own words is clearly and unambiguously referring to; Lemon to the contrary
26 does describe and claim using a tablet to generate spontaneous markings thereon *which*
27 *become Internet links in and of themselves*. Bates nowhere in his own words describes,
28 suggests nor motivates such an application. Moreover, graphic tablets operate in one of two
29 modes: absolute coordinate mode and relative coordinate mode. The use of the term
30 "conventional mouse" clearly recognizes that Bates would be using a tablet in the relative

1 coordinate mode. The is the exact opposite of applicant Lemon's technique which uses a tablet
2 in the absolute coordinate mode.

3
4 The Action also alleges

5 "...Bates demonstrates a first surface region where the annotating fuction commands are
6 implemented (area 750.)"

7
8 "Create icon button 750" is clearly described and defined in col. 10:lines 16-34 as a region of
9 the display screen. The characterization of this as equivalent to applicant's spontaneously
10 generated "mnemonic hint 213" drawn freehand on a tablet is an extreme extrapolation of the
11 concept Bates is discussing using the present application for inspiration to do so. Hindsight
12 reasoning using the invention for which a patent is sought as a template is impermissible.
13 Texas Instruments, Inc. v. ITC, 26 USPQ2d 1018 (CA FC 1993).

14
15 It is respectfully requested that the rejection be withdrawn.

16
17 RESPONSE TO REJECTION UNDER ACTION PARA. 4

18
19 The Action cites U.S. Pat. No. 5,592,607 (Weber et al.) in combination with Bates against claims
20 3, 5-15, and 17-20.

21
22 Bates has been shown hereinabove to be misapplied. Any combination with it must fail prima
23 facie and the rejection withdrawn.

24
25 However, in order to further prosecution, applicant also offers the following rebuttals to the
26 Office allegations.

1 Re Claim 3

2
3 Dependent claim 3 further specifies:

4 “..freehand symbols indicative of the preselected data address are entered.”

5 Moreover, perforce of claim 1, in and of themselves these symbols on the tablet become
6 Internet links.

7
8 Weber et al. is understood by the applicant to be merely a fundamental patent to the computer
9 tablet product line and a different problem related thereto. Weber’s claim 26, for example, is to
10 “An interactive, processor-controlled system for *storing in a data structure for later retrieval* time-
11 stamped, handwritten information entered by a system user; ...” This is a highly different,
12 persistent storage approach. The present applicant neither stores nor retrieves from a data
13 base. Applicant Lemon’s mnemonic marks exist only e.g. as ink on paper covering a tablet.
14 Moreover, Weber’s indexing scheme must employ a system clock for the time stamping and
15 uses those events to link written notes. The present invention is to the opposite in that it uses
16 written mnemonic marks to link web pages without such requirements.

17
18 The Action however cites it for the proposition that:

19 “One skilled in the art understands that Internet addresses are certainly events that need
20 to be recalled [sic, ;]a fact that is well established by Bates.”

21 Again, this is pure extrapolation in admitted hindsight based upon the present disclosure by
22 Lemon. Moreover, in In re Newell, 13 USPQ2d 1248, 891 F.2d 899 (Fed. Cir. 1989) the court
23 explicitly stated that:

24 “[I]n deciding that a novel combination would have been obvious, there must be
25 supporting teaching in the prior art.”; “[A] retrospective view of *inherency* is not a
26 substitute for some teaching or suggestion which supports the selection and use of the
27 various elements in the particular claimed combination.” (At 1250, emphasis added.)

28 The Office’s argument is equivalent to claiming an inherent idea of the Internet access being
29 recurrent.

1 It is respectfully requested that the rejection be withdrawn on this ground also.

2
3 In re Claims 5, 6 and 7

4
5 Claim 5 herein is independent; claims 6 and 7 are depending therefrom. Like claim 1, it
6 provides for different aspects not disclosed, suggested, nor motivated by Bates nor by a
7 combination of Bates and Weber et al. except at best by using Lemon as a template.
8 Differentiating from Bates, Lemon at the least claims,

9
10 "...associating an address indicative of the first of said sites with a first location
11 coordinate address on a computer writing tablet via a first visible marking a first
12 random location on said writing tablet during access of said first of said sites;
13 accessing a second of said sites; and
14 associating an address indicative of said sites with a second location coordinate address
15 on a computer writing tablet via a second visible marking on a second random
16 location on said writing tablet during access of said second of said sites." Emphases
17 added as to differentiating elements.

18
19 Claims 6 and 7 should be allowed as depending from a claim having clear distinctions from the
20 reference. Withdrawal of the rejections is respectfully requested.

21
22 In re Claim 8

23
24 Claim 8 is independent; rejected on the same grounds used against claims 3, 5 and 6. Again,
25 the allegation can not be sustained because Lemon claims,

26 "...associating an input-output port of the tablet with signals indicative of Internet-
27 associated computer data addresses;
28 when each of a plurality of the Internet-associated computer data addresses is
29 accessed, writing a mnemonic object associated therewith respectively, wherein a location

1 on said tablet of the mnemonic object is coupled to a current one of said Internet-
2 associated computer data addresses; and

3 accessing any specific one of said plurality of the Internet-associated computer data
4 addresses by selecting the mnemonic object associated therewith. Emphases added.

5
6 Again, clearly there are novel, non-obvious elements which can, at best, only be extrapolated
7 from the references using the present application as the template. Withdrawal of the rejection is
8 respectfully requested.

9
10 In re Claims 9 and 10

11
12 Claims 9 and 10 should be allowed as depending from a claim having clear distinctions from the
13 reference. Moreover, the allegation against claim 10 admittedly is explicitly based on a
14 implication rather than any disclosure and is improper under the In re Newell decision.
15 Withdrawal of the rejection is respectfully requested.

16
17 In re Claim 11

18
19 Claim 11 is independent and rejected on the same grounds as claims 3 and 7. It includes,

20 "11. (CURRENTLY AMENDED) A computerized method comprising:

21 accessing an internet site; [[and]]

22 associating an address of the site with a writable-erasable mnemonic device in a
23 computer writing tablet; and

24 accessing said site via said mnemonic device.

25
26 Again, only using Lemon as a template can the references even be extrapolated to teach,
27 suggest or motive such element. Nowhere in their own words do the references provide such.
28 Withdrawal of the rejection is respectfully requested.

29
30 In re Claims 12, 13 and 14

1 Claims 12, 13 and 14 should be allowed as depending from a claim having clear distinctions
2 from the reference. Withdrawal of the rejections is respectfully requested.

3
4 In re Claim 15

5
6 Claim 15 is independent. It provides for,

7 "...computer code for recording temporary symbols associated with an Internet site
8 address;

9 computer code associating the Internet site address with a writable-erasable
10 mnemonic device in a computer writing tablet for receiving said temporary symbols; and

11 computer code for accessing said Internet site address via said temporary symbols.

12
13 Again, only using Lemon as a template can the references even be extrapolated to teach,
14 suggest or motive such element. Nowhere in their own words do the references provide such.
15 Withdrawal of the rejection is respectfully requested.

16
17 In re Claim 17-20

18
19 Claim 17 is independent; claims 18, 19 and 20 depend therefrom. Claim 17 as amended
20 provides for,

21 "...associated with the combination of internet access device, writing tablet and stylus,
22 program code using said tablet for generating bookmarks thereon related to respective search
23 resultant internet sites such that said sites are accessible directly via said bookmarks."

24
25 Again, only using Lemon as a template can the references even be extrapolated to teach,
26 suggest or motive such element. Nowhere in their own words do the references provide such.
27 Moreover, the allegation against claim 20 admittedly is explicitly based on a inherency rather
28 than any disclosure and is improper under the In re Newell decision.

29
30 Withdrawal of the rejections is respectfully requested.

1 SUMMARY AND CONCLUSION

2
3 Applicant has shown specific technical differences above which eliminate all the references
4 cited. The claims as amended are unambiguously distinct from the references which the Office
5 has cited in this and two prior Office Actions. It is clear that Lemon's invention is novel and non-
6 obvious. Therefore, all grounds for rejection have been overcome.

7
8 Moreover, legal reasons for rejection of each of the references have been and can be raised. It
9 is respectfully submitted that to support a true and valid contention of obviousness, the law
10 provides that the Office must present evidence of elements *as described in* various cited
11 references wherein those elements, if not identical, are at least technically *and functionally*
12 equivalent to applicants claimed elements, *and that the references themselves* provide
13 suggested use and motivation for the combination. As long as the Office continues to attempt to
14 *redefine* a reference element's true description *as given by the patentee therein* to fit it into an
15 alleged relationship to the present applicants invention, rather than using the patentee's own
16 description to establish such a relationship, the Office violates both the rules laid down by its own
17 Board and the Courts. The use of hindsight reconstruction, alleged inherencies in prior art, and
18 tortuous construction of references can not survive technical nor legal scrutiny. Unless the
19 Office has truly analogous evidence *in the references' own terms*, rather than recouched into
20 applicant's terms to fit the objection, such a reference simply can not withstand good technical
21 scrutiny nor logic. As such, both the Office and the applicants are repeatedly submitted to the
22 time and expense of flawed analyses. In other words, from a legal perspective, the approach
23 used in the current Office Action itself is without legal justification. Again providing another
24 reason why the rejections should be withdrawn.

25
26 Based upon the foregoing, it is submitted that the application now presents claims which are
27 directed to novel, unobvious and distinct features of the present invention which are an
28 advancement to the state of the art. Reconsideration and early allowance of all claims is
29 respectfully requested. The right is expressly reserved to reassert any and all arguments,
30 including the raising of new arguments, should a Notice of Allowance not be forthcoming.

1 Applicant reserves the right to reinsert claims and to prosecute claims via continuing and
2 divisional applications.

3
4 Questions or suggestions that will advance the case to allowance may be directed to the
5 undersigned by teleconference at the Examiner's convenience.

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7 Date: Apr. 7, 2004

8 Respectfully submitted,
9 Hewlett-Packard Company

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